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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kazuhiko Ueda

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EXAMINER

HENDRICKS, KEITH D

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,759

Applicant(s)

UEDA ET AL.

Examiner

Keith Hendricks

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-29 and 31-34 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 27-29 and 31-34 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Food product claims 15-26 have been cancelled in the amendment of March 9, 2006. Claims 27-29 and 31-34 are currently pending and examined.

Claim Objections

Claim 32 remains objected to because of the following informalities: it is believed that the term “potate” should be “potato”. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

i) Claims 27-29 remain rejected under 35 U.S.C. 102(b) as being anticipated by Meer et al. (US PAT 5,073,370, of record). The reference and rejection are taken as cited in a previous Office action.

Applicant's arguments filed March 09, 2006 have been fully considered but they are not persuasive. At pages 4-5 of the response, applicant states that “however, in Meer et al., the apple fiber is used merely as a source of dietary fiber... and gum arabic is used for the purpose of merely providing a texture and an additional fiber.” Applicant further states that “the present invention was arrived at by the present inventors who found through trials and errors that a certain (claimed) polysaccharide, not disclosed in the Meer et al. patent, has a capability of reducing the viscosity of an aqueous solution of psyllium, and thus this significant effect of the present invention could not be obvious to those skilled in the art in view of Meer et al.”

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This is not deemed persuasive for the reasons of record. Initially, applicant's statement that the claimed polysaccharide was not disclosed in Meer et al., is not deemed persuasive. It has been clearly stated on the record that Meer et al. disclose a powdered fiber laxative comprising psyllium powder, apple fiber, fructose and gum arabic. The apple fiber is a source of dietary fiber, and together with psyllium, make up at least 75% by weight of the composition. Thus applicant's statement is unfounded and not on point.

Secondly, apparently despite the fact that the reference discloses the mixture (i.e. addition of) psyllium powder, apple fiber, fructose and gum arabic, applicant states that "the apple fiber is used merely as a source of dietary fiber", and that any reduction in the viscosity of psyllium in an aqueous solution "could not be obvious to those skilled in the art in view of Meer et al." This is not deemed persuasive for the reasons of record. Recognition of a particular property by a prior art reference is not required for anticipation. The required claimed components and method steps are present in the reference, which is all that is required to anticipate the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In the instant case, it does not. If the prior art structure is capable of performing the intended use, or in the instant case, possesses the claimed properties, then it meets the claim. Further, simply because applicant has recognized another advantage (i.e. "determined" or "found" a particular "effect", as stated by applicant) which would be inherently present in the prior art reference, this cannot be the basis for patentability.

Finally, it is noted that although independent claim 27 makes reference to an aqueous solution containing psyllium, the only required actual and tangible method step within the claim is the "step of adding a polysaccharide to the psyllium." It is not required that this take place within the aqueous solution, and furthermore, the actual presence or necessity of the aqueous solution as part of the claimed invention is not specifically required by the claim. The reference to the aqueous solution is simply a future property of the composition such that the combined composition imparts a particular property to psyllium (if and) when in an aqueous solution, which composition results from the "step of adding a polysaccharide to the psyllium." The addition of said composition with water would require a separately-stated step. Applicant's specification describes the addition of the two components (polysaccharide and psyllium) outside of water, but does not actually provide for the separate combining of these components within water, and thus the claims must be interpreted as such. See, for example, the paragraph spanning pages 6-7 of the specification.

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ii) Claims 27-29 remain rejected under 35 U.S.C. 102(e) as being anticipated by Sander (US PAT 6,312,730, of record). The reference and rejection are taken as cited in a previous Office action.

Applicant's arguments filed March 09, 2006 have been fully considered but they are not persuasive.

At page 5 of the response, applicant states:

Sander discloses a laxative comprising psyllium coated with gum arabic that is a polysaccharide. However, in Sander, psyllium is coated with arabic for the purpose of improving dispersiveness of the psyllium, and thus 'a method of reducing viscosity of an aqueous solution containing psyllium' containing the claimed polysaccharide having a molecular weight of at least 20,000 and the claimed viscosity is not disclosed. Sander discloses only an invention in which psyllium is coated with gum arabic but Sander neither discloses nor suggest a combination of a certain polysaccharide of the present invention and psyllium. Therefore, the present invention could not be anticipated by Sander.

This is not deemed persuasive for the reasons of record. From applicant's response, it appears that applicant (a) acknowledges that the reference indeed discloses a combination of psyllium and a polysaccharide which is a dietary fiber (gum arabic) and thus meets the claim limitations, yet (b) somehow states that this cannot anticipate the claim invention. This is not deemed persuasive for the reasons of record, as applicant has failed to specifically address the points raised in the rejection with respect to the particular teachings of the reference. As previously stated on the record, the Sander patent discloses a powdered fiber laxative comprising psyllium powder and gum arabic, where the gum arabic is used to coat the psyllium component. *Gum arabic is both a polysaccharide and a natural, soluble fiber (bottom col. 3)*, i.e. a dietary fiber which meets the claim limitations. Thus applicant's statements are unfounded and not on point.

Further, it is noted that although independent claim 27 makes reference to an aqueous solution containing psyllium, the only required actual and tangible method step within the claim is the "step of adding a polysaccharide to the psyllium." It is not required that this take place within the aqueous solution, and furthermore, the actual presence or necessity of the aqueous solution as part of the claimed invention is not specifically required by the claim. The reference to the aqueous solution is simply a future property of the composition such that the combined composition imparts a particular property to psyllium (if and) when in an aqueous solution, which composition results from the "step of adding a polysaccharide to the psyllium." The addition of said composition with water would require a separately-stated step. Applicant's specification describes the addition of the two components (polysaccharide and psyllium) outside of water, but does not actually provide for the separate combining of these components

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within water, and thus the claims must be interpreted as such. See, for example, the paragraph spanning pages 6-7 of the specification.

iii) Claims 27-29, and 31-32 remain rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-174558 (of record; computer-generated English translation). The reference and rejection are taken as cited in a previous Office action.

Applicant's arguments filed March 09, 2006 have been fully considered but they are not persuasive. At page 5 of the response, applicant states:

JP '558 discloses a composition for use in noodles containing a modified starch and psyllium seed gum. Thus, where water is added to the composition, the aqueous solution of JP '558 comprises psyllium and a polysaccharide. The polysaccharide however, does not meet the features of applicants' claimed polysaccharide.

... The invention of JP '558 neither discloses nor suggests decreasing viscosity of an aqueous solution containing psyllium by adding applicants' claimed polysaccharide and therefore, does not provide the effect accomplished by the claimed invention.

This is not deemed persuasive for the reasons of record. From applicant's response, it appears that applicant (a) acknowledges that the reference indeed discloses a combination of psyllium and a polysaccharide which is a dietary fiber (modified starch) and thus meets the claim limitations, yet (b) somehow states that this cannot anticipate the claim invention. This is not deemed persuasive for the reasons of record, as applicant has failed to specifically address the points raised in the rejection with respect to the particular teachings of the reference. As previously stated on the record, The modified starches are produced from numerous sources, including waxy corn starch, potato and tapioca starch (pg. 5, or paragraph 14). Various known methods of starch modification are provided, including etherification, esterification, acetylation of the hydroxyl groups of the starch, etc. (pg. 6, or paragraph 13). Thus, not only does the reference generally provide a "modified starch" as broadly recited in claim 27, but it provides a teaching of the specific modified starches of dependent claims 31-32.

Regarding the fact that the reference produces a noodle product, it is noted that page 9 of applicant's specification states that preferably when making a food product containing water, the "starting material itself contains water, a food prepared by adding water during its manufacturing process, or a food intended to be prepared or cooked by adding water just before eating, such as noodles...".

Further, recognition of a particular property by a prior art reference is not required for anticipation. The required claimed components and method steps are present in the reference, which is all that is required to anticipate the claimed invention. A recitation of the intended use of the claimed

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invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In the instant case, it does not. If the prior art structure is capable of performing the intended use, or in the instant case, possesses the claimed properties, then it meets the claim. Further, simply because applicant has recognized another advantage (i.e. “determined” or “found” a particular “effect”, as stated by applicant) which would be inherently present in the prior art reference, this cannot be the basis for patentability.

Finally, it is noted that although independent claim 27 makes reference to an aqueous solution containing psyllium, the only required actual and tangible method step within the claim is the “step of adding a polysaccharide to the psyllium.” It is not required that this take place within the aqueous solution, and furthermore, the actual presence or necessity of the aqueous solution as part of the claimed invention is not specifically required by the claim. The reference to the aqueous solution is simply a future property of the composition such that the combined composition imparts a particular property to psyllium (if and) when in an aqueous solution, which composition results from the “step of adding a polysaccharide to the psyllium.” The addition of said composition with water would require a separately-stated step. Applicant’s specification describes the addition of the two components (polysaccharide and psyllium) outside of water, but does not actually provide for the separate combining of these components within water, and thus the claims must be interpreted as such. See, for example, the paragraph spanning pages 6-7 of the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 33-34 remain rejected under 35 U.S.C. 103(a) as being unpatentable over either of Meer et al. or Sander, taken as cited above, each in view of Gonze et al. (US PAT 5,976,582). The references and rejection are taken as cited in a previous Office action.

Applicant did not address or traverse this rejection, and thus applicant apparently acquiesces the propriety of the rejection. It remains for the reasons of record.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KEITH HENDRICKS
PRIMARY EXAMINER